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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,377	03/21/2001	Robert David Freeman	4154-11-CIP	3940

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MACPHERSON KWOK CHEN & HEID LLP
1762 TECHNOLOGY DRIVE, SUITE 226
SAN JOSE, CA 95110

EXAMINER

WATKO, JULIE ANNE

ART UNIT	PAPER NUMBER
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2652

DATE MAILED: 10/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/815,377

Applicant(s)

FREEMAN ET AL.

Examiner

Julie Anne Watko

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 10-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 May 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 19.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Species A, drawn to Figs. 3-12, in Paper No. 18, filed June 17, 2003, is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. On page 1 of the election of Paper No. 18, filed June 17, 2003, Applicant states that claims 1-13 are readable on the elected species. Claims 14-21 are withdrawn from consideration as non-elected. The non-election of claim 14 has been interpreted as an admission that claim 14 is not generic. Furthermore, the Examiner asserts that claims 10-11 are drawn to Species F, not Species A. Moreover, the Examiner asserts that claims 12-13 are readable on Species D, not Species A. Claims 10-13 are also withdrawn from consideration as non-elected.
3. Claims 1-9 are hereby treated on the merits.

Information Disclosure Statement

4. On form 1449 of the IDS filed September 19, 2002, foreign patents have been listed under "other art". These should have been listed under "foreign patent documents". The Examiner has cited the foreign patents on form 892. Although no copy will be provided to Applicant, the foreign patents have been considered.

Drawings

5. The drawings were received on May 10, 2002. These drawings are disapproved.
No permanent magnet 242 appears in Figs. 23-29. This is inconsistent with page 26, lines 5-6 and 13, "magnet 242".

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In Fig. 24, 238' appears to be a coil, and 238 appears to not be a coil. This is inconsistent with the Specification, page 26, line 13, "coil 238".

Specification

6. The abstract of the disclosure is objected to because it does not reflect the claimed subject matter. Correction is required. See MPEP § 608.01(b).

7. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

8. The use of the trademark KEVLAR has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

9. The Examiner politely requests that Applicant update the status (abandoned, pending, etc.) of each related application mentioned in the first paragraph of the specification, including the serial number of any concurrently filed applications, and the patent numbers of any issued cases.

Claim Objections

10. Claim 6 is objected to because of the following informalities: Claim 6 recites the limitation "said second and third planar elements" in lines 1-2. No "second and third planar elements" have been previously recited. The Examiner suggests -- [said] a second and third of said planar elements --. Appropriate correction is required.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitation “kevlar” in line 3. It is noted that the trademark KEVLAR identifies the source of a product, not its composition. The composition of KEVLAR products may change over time; thus, it is impossible for a person of ordinary skill in the art to ascertain the metes and bounds of the claim.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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15. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stole et al (US Pat. No. 6091578) in view of Ogawa et al (US Pat. No. 6052357).

As recited in claim 1, Stole et al shows a disk drive comprising: a housing 210 including a base portion 122; a disk 128 having information on at least one side; said disk rotatably mounted on a first shaft 126; an actuator assembly having a first portion 130 and a second portion (including 134 and 150) and being pivotally mounted to a second shaft (inside 140) for positioning the second end relative to the surface of the disk, said second portion comprising a plurality of planar elements (134 and 150, for example); and a pick up unit 136 disposed on said second portion of said actuator.

As recited in claim 1, Stole et al are silent regarding the drive being an optical drive, the disk being an optical disk, and the pick up unit being an optical pick up unit, said optical pick up unit acting to focus a light beam on said optical disk.

As recited in claim 1, Ogawa et al show an optical drive 10 (see Fig. 1), an optical disk 17, and an optical pick up unit 50 acting to focus a light beam on said optical disk.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the magnetic disk and pick up unit of Stole et al with the optical disk and optical pick up unit of Ogawa et al to create an optical drive as taught by Ogawa et al. The rationale is as follows: one of ordinary skill in the art would have been motivated to replace the disk and pick up unit with the optical disk and optical pick up unit in order to increase a data storage density and to reduce bulk as taught by Ogawa et al ("the device is still bulky and provides only a limited storage capacity. Under such a situation, there is a proposal to construct an optical disk device that is capable of replacing the recording medium. According to the optical

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disk device of such a construction, a large storage capacity is guaranteed as a result of use of the optical recording and reproducing technique”, see col. 1, lines 29-37).

As recited in claim 2, Stole et al show that said second portion comprises at least three planar elements (see Fig. 3, which shows at least three planar elements 134 and at least three planar elements 150).

As recited in claim 3, Stole et al show that a first of said planar elements comprises a flexible member 150.

As recited in claim 4, Stole et al show that second 150 and third 150 of said planar elements are disposed on opposite sides of said flexible member.

As recited in claim 5, Stole et al show spacer member 312.

As recited in claim 6, Stole et al show that second 134 and third 134 planar elements comprise a plurality of layers (see Fig. 5A, for example).

As recited in claim 7, Stole et al show that said second and third planar elements comprise eight layers each (see col. 8, line 43, “more or less layers than five” are disclosed, a range which includes the claimed number).

As recited in claim 8, Stole et al show that said layers are fiber composite material (“composite material” with “elongated fibers”, see col. 6, lines 22-25).

As recited in claim 9, to the extent understood, Stole et al show that the fibers are selected from the group comprising carbon, magnesium, boron, beryllium, glass and ceramic (“carbon or boron or a similar material which has high tensile strength”, see col. 6, lines 25-27; see also col. 9, lines 26-53, “silicon carbons with a SiC, Bal, boron, Bal₂SiO₃, alumina, or any other continuous filament fiber”, graphite “KL100”).

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Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nakajuma et al (US Pat. No. 3918722) show a phonograph tone arm made by winding resin impregnated sheets of carbonaceous fiber (see Fig. 5) about a flexible mandrel (see Fig. 4). Ruiz et al (US Pat. No. 5771135) show a magnetic head suspension comprising layers (see Fig. 2) of stainless steel 70, polyimide 74 and beryllium copper alloy 78.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie Anne Watko whose telephone number is (703) 305-7742. The examiner can normally be reached on Mon&Tue until 2PM, Th until 5PM, Wed&Fri all day.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (703) 305-9687. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Julie Anne Watko
Examiner
Art Unit 2652

October 16, 2003
JAW

